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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/862,905	05/22/2001	Gary P. Kasner	1915.14US03	9685

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EXAMINER

SAFAVI, MICHAEL

ART UNIT	PAPER NUMBER
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3673

DATE MAILED: 11/06/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/862,905

Applicant(s)

KASNER ET AL.

Examiner

M. Safavi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 16-48 is/are pending in the application.
- 4a) Of the above claim(s) 35-48 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on May 22, 2001 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 16-34 are, drawn to ventilator, classified in class 454, subclass 365.
  - II. Claims 35-39 are, drawn to method of ventilating a building attic, classified in class 52, subclass 747.1.
  - III. Claims 40-48 are, drawn to method of forming a ventilator, classified in class 29, subclass 897.3.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions III and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case claimed ventilator can be made without removing a portion of the top panel, (first ply or intermediate ply), to form the recessed area and without forming the top panel and pair of ventilator section first panels from “the material”.
3. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case claimed ventilator can be used as side vent or corner vent

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apparatus without being placed upon a roof and the claimed method does not require an arcuate cross section recessed area within the top panel.

4. Inventions II and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because claimed combination does not require forming the top panel and pair of ventilator section first panels from “the material”. The subcombination has separate utility such as forming a vent for use along side or corner of a building, (or as a vent for any particular construction), without being placed upon a roof of a building.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

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7. Newly submitted claims 35-48 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: see above restriction requirement

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation within the original application for prosecution on the merits. Accordingly, claims 35-48 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.176 and MPEP § 1450.

### *Specification*

The specification is objected to as failing to include a cross reference to the other reissue applications in the first sentence of the specification.

37 CFR 1.177(a) requires that all multiple reissue applications resulting from a single patent must include as the first sentence of their respective specifications a cross reference to the other reissue application(s). Accordingly, the first sentence of each reissue specification must provide notice stating that more than one reissue application has been filed, and it must identify each of the reissue applications and their relationship within the family of reissue applications, and to the original patent.

Pursuant to 37 CFR 1.177(a), if the parent reissue application issues without any cross reference to the continuation, amendment of the parent reissue patent to include a cross-reference

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to the continuation must be effected at the time of allowance of the continuation application by Certificate of Correction.

***Claim Rejections - 35 USC § 251***

8. The reissue oath/declaration filed with this application is defective because none of the errors which are relied upon to support the reissue application are errors upon which a reissue can be based. See 37 CFR 1.175(a)(1) and MPEP § 1414. The reissue Declaration filed with the application does not set forth errors applicable to the claims specifically recited within paragraphs 5, 6, and 7 of the Declaration. The reissue Declaration merely states presumption with no factual basis for why the patent would be inoperative as found. Further the claims 16-34 do not appear to specifically address the errors set forth in paragraphs 5-7 of the Declaration. Rather, claims 16-34 appear to set forth the invention in a varying and broadened scope than that presented within the original patent. The Declaration does not address any errors applicable to claims 1-15 which have been canceled by this reissue application and does not address claims 16-34 which have been added by the instant reissue application. For example, claim 16 as presented with the filing of the presently filed reissue application now claims only "at least one ventilator section..." and further appears to define a ventilator per se.

Further, the specification appears to have been amended with no expression in the Declaration as to the errors within the specification which may have precipitated any such

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amendment. In accordance with 35 U.S.C. 251, the error upon which a reissue is based must be one which causes the patent to be "deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent." Thus, an error under 35 U.S.C. 251 has not been presented where the correction to the patent is one of spelling, or grammar, or a typographical, editorial or clerical error which does not cause the patent to be deemed wholly or partly inoperative or invalid for the reasons specified in 35 U.S.C. 251. These corrections to a patent do not provide a basis for reissue (although these corrections may also be included in a reissue application, where a 35 U.S.C. 251 error is already present). These corrections may be made via a certificate of correction; see MPEP § 1481.

9. Claims 16-34 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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10. Claims 16-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 16, lines 4 and 10, "each said ventilator section" lacks an antecedent basis within the claim. Line 6, "each said ventilator first panel" lacks an antecedent basis within the claim. Further, it is not clear as to what is being defined by the language of claims 16-34 with lines 4-5 of claim 16 reciting "each said ventilator section configured for parallel abutting contact with the top panel". Do claims 16-34 define an assembled ventilator or merely portions of a ventilator which may be assembled together? The metes and bounds of claims 16-34 can, therefore, not be ascertained.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Safavi whose telephone number is (703) 308-2168.

M. Safavi  
November 4, 2002